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FROM: **Sara Geer - 2081**RE: **U.S. Appl. No: 10/840032
Wiggle Flyer**CLIENT/MATTER NO.: **100444.0018US1** NUMBER OF PAGES, INCLUDING COVER: **8**

MESSAGE:

Please find attached Notice of Appeal and Pre-Appeal Brief Review Request.

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DEC 21 2005

Application No.: 10/840,032
Applicant: William M. Forti
Filing Date: May 5, 2004
Art Unit: 3725
Examiner: Miller, Bena B.
Attorney Docket No: 100444.0018US1

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This is a response to the Final Office Action mailed September 26, 2005. A Notice of Appeal accompanies this response.

Argument begins on page 2 of this paper.

100444.0018US1

1

ARGUMENT

Status

In the final Office action dated September 26, 2005, the Examiner rejected:

- (a) Claims 1-8 as being anticipated by Ming (U.S. Pat. No. 6,461,220);
- (b) Claims 1 and 3-8 as being anticipated by Pacza (U.S. Pat. No. 6,361,395);
- (c) Claims 9-16 as being obvious over Ming; and
- (d) Claims 9 and 11-16 as being obvious over Pacza.

In support of the anticipation rejections, the Examiner recites selected limitations of the presently pending claims and correlates these to various elements in the drawings of Ming and Pacza (see page 2, and first third of page 3 of final office action). Similarly, in support of the obviousness rejections, selected limitations of the presently pending claims were correlated with various elements in the drawings of Ming and Pacza (see page 3 and first paragraph of page 4 of final office action), and the Examiner further alleges that provision of instructions on how to use the toy would have been a mere design choice.

In response to the applicant's arguments, the Examiner states that the applicant argued on the basis of the reference's failure to teach an intended use of the reference's toy. The Examiner then elaborates that if a prior art structure would be capable of performing the intended use, then it meets the claim (see page 4, section response).

(1) The Examiner Fails To Identify Each And Every Claimed Limitation In The Cited Reference

Independent claim 1 expressly requires that the "...spiral-shaped tail comprises a material that maintains a spiral shape of the tail during flight when the toy is thrown into the air by a user...". Independent claim 1 further expressly requires that the "...the spiral-shaped tail curves around the longitudinal axis to a degree effective to impart rotation of the tail about the longitudinal axis during flight..." *These limitations are clearly not addressed by the Examiner.*

While one cannot establish novelty by claiming a known material by its properties (see e.g., *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *Titanium Metals Corp. of Am. v. Banner*,

778 F.2d 775, 782 (Fed. Cir. 1985); *In re Pearson*, 494 F.2d 1399, 1403 (CCPA 1974); *In re Benner*, 36 C.C.P.A. 1081, 174 F.2d 938, 942 (CCPA 1949)), it is well established that *patent applicant is free to recite features of an apparatus either structurally or functionally* (see e.g., *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 U.S.P.Q. (BNA) 226, 228 (CCPA 1971)).

It should be apparent from the claim language that a *functional feature of an element in the claimed apparatus is recited*. Moreover, the applicant has provided *express definitions* for such language in the specification (see e.g., page 5, lines 9-22; page 4, lines 23 *et seq.*), which the Examiner appeared to have entirely ignored. Clearly, claim 1 does not recite a new use of a known device, but is drawn to a new *device in which an element has a feature that is functionally described*. The above recited elements are not found in the Ming and Pacza patents. Therefore, the anticipation rejection is improper and should be withdrawn.

(2) The Examiner Incorrectly Cites Applicant's Arguments

The Examiner's statement (final action, page 4, second paragraph) that "...Applicant's argument that Ming fails to teach the intended use of the claims..." is *simply incorrect*. Neither did the applicant argue that Ming would fail to teach a particular claimed use, nor did the applicant argue that a particular use was claimed.

(3) The Examiner Fails To Properly Establish Obviousness

The Examiner argues in the final office action that "...It would have been a mere design choice to provide instructions with the toy of Ming for the purpose of instructing a person on how to use the toy..." Unfortunately, *the Examiner's statement is not reflective of the claimed subject matter*. What is claimed is an "...instruction to a user to *propel the flying toy into the air to impart rotation* of the tail about the longitudinal axis during flight...", which is neither taught nor suggested by the references. Thus, one critical element of a proper obviousness rejection is lacking. The assertion that the particular and claimed contents of the instructions would have been a matter of design choice amounts to a general but unsupported conclusion of the Office,

which does not substitute for authority when the law requires authority (see e.g., *In re: Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697).

Furthermore, *both cited references indeed teach against the claimed subject matter*. For example, Ming teaches that the "...The spring coil is made from the plastic or metal stripes with *superb extendibility*...", which is clearly reflected in Figures 7-1 and 7-2. Similarly, Pacza teach that the "...coil is an expansion spring with a relatively low spring coefficient, which allows it to be manipulated easily and expanded...therefore *change dramatically in size* when manipulated and then spring back to the original configuration...". This property is also reflected in Figures 4 and 5. In contrast, the applicant's device is generally rigid and the tail will maintain its shape during flight (see definitions in specification from page 4, line 3 to page 5, line 22). Therefore, Ming and Pacza are not only inconsistent with the claimed subject matter, but directly teach against the pending claims.

Based on at least these considerations, the applicant is of the position that the Examiner failed to properly establish obviousness of claims 9-16. Therefore, the present rejections should be withdrawn.

Conclusion

In its rush to reject the claims, the Office failed to consider all of the limitations in the presently pending claims, ignored express definitions for the terms which would have provided even more clarity, and further failed to properly establish obviousness for various reasons. The rejections should be withdrawn.

Respectfully submitted,



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Dated: December 12, 2005

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APPENDIX

The below shown independent claims reflect the rejected claims as presently pending and entered in response to the non-final office action dated October 19, 2004.

1. A flying toy comprising:
a head portion that is fixedly coupled to a spiral-shaped tail, wherein the spiral-shaped tail comprises a material that maintains a spiral shape of the tail during flight when the toy is thrown into the air by a user;
wherein the spiral-shaped tail has a longitudinal axis and a configuration other than a screw; and
wherein the spiral-shaped tail curves around the longitudinal axis to a degree effective to impart rotation of the tail about the longitudinal axis during flight.
9. A game kit comprising:
a flying toy that includes a head portion that is fixedly coupled to a spiral-shaped tail, wherein the spiral-shaped tail comprises a material that maintains a spiral shape of the tail during flight;
wherein the spiral-shaped tail has a longitudinal axis and a configuration other than a screw;
wherein the spiral-shaped tail curves around the longitudinal axis to a degree effective to impart rotation of the tail about the longitudinal axis during flight; and
an instruction to a user to propel the flying toy into the air to impart rotation of the tail about the longitudinal axis during flight.